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STATUS OF THE CLAIMS

This is in response to the Office action mailed November 21, 2006, in which the examiner responded to the previously filed appeal brief by reopening prosecution with a new ground of rejection of claims 2, 4, 5, 7, 8 and 12-18. Claims 6, 10, and 11 have been allowed and claims 9, 19, and 20 have been indicated to be allowable pending being rewritten to incorporate the subject matter of their parent claims. The applicant respectfully requests reconsideration of the rejection of claims 2, 4, 5, 7, 8 and 12-18 in light of the present response.

CLAIMS 2, 4, 5, 7, 8, AND 12-18 ARE NOT RENDERED OBVIOUS

BY BLACK AND CLARK

In the Office action, the examiner rejected claims 2, 4, 5, 7, 8 and 12-18 under 35 U.S.C. §103(a) as being unpatentable over Black (U.S. Patent No. 4,185,846) in view of Clark et al. (U.S. Patent No. 6,476,603). Black is directed to a rough terrain creeper, while Clark is directed to a brush assembly for magnetic induction testing of the structural integrity of railroad rails. The brush assembly involves engaging a surface and conducting electricity to and from the railroad rails, for use in evaluating structural flaws thereof.

This disparate combination of references dressed up as an alleged rationale for showing obviousness suffers from a set of problems that has grown familiar in the prosecution of the present application. Quite simply, the field of art concerned with applying magnetic induction to railroad rails to investigate their structural integrity has no common sense connection with the field of art of mechanic's creepers, and combining teachings from these two disparate fields is not relevant to a proper evaluation of obviousness. As the U.S. Supreme Court has recently clarified, "A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art." *KSR Int'l. Co. v. Teleflex Inc.*, 550 U. S. ____ (2007) (slip op. at 14). The rejection of the present claims constitutes a textbook example of just what the Supreme Court warned against here, of listing individual elements disclosed by widely disparate areas of prior art, without properly evaluating

whether such mutually remote elements might truly all have been encompassed within the common sense of a person of ordinary skill in the art of the present application.

Furthermore, the effort to repeat the same erroneous strategy of alleging obviousness based on a manifestly disconnected hodgepodge of references, with only a reshuffling of the particular references cited, after abandoning the same strategy in the venue of the prior appeal, does not serve well to advance the prosecution of the present application.

Black and Clark do not provide a rational basis for finding any of the present claims obvious for a variety of reasons, including because Clark is not analogous art; because there would have been no motivation or other common sense prompting to make the cited combination; because Black and Clark teach away from combination with each other; and because the devised combination takes no rational account of the skill, creativity, or common sense of those in the art of mechanic's creepers. Indeed, the Office has now taken the opportunities of four Office actions spanning more than two years, yet still without producing a purported basis for obviousness that does not rely on collecting references from outlandishly unrelated fields of art.

Ultimately, the rejection of the present claims drops an overly and unstatutorily strict gate in the way of the allowance of the patentably inventive present claims. Since "[v]irtually all inventions are combinations... of old elements", *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 1161, 1179 (Fed Cir. 1991) (cit. omitted), a proper evaluation of the factors pronounced in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966) – including distinctions of non-analogous art, lack of motivation to combine references, references teaching away from each other, and properly evaluating the ordinary level of skill in the pertinent art – are of critical importance for protecting the inventive and patentable combinations of the present claims from an unfairly broad application of §103. Proper consideration of these factors compels the conclusion that claims 2, 4, 5, 7, 8, and 12-18 are not obvious and should be allowed.

1. CLAIMS 2, 4, 5, 7, 8, AND 12-18 ARE NOT RENDERED OBVIOUS
BECAUSE BLACK AND CLARK ARE NOT FROM ANALOGOUS ARTS

The scope and contents defined by Black and Clark would not render the claims obvious, in particular, because Clark is not from an art analogous to the present claims. A reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. M.P.E.P. 2141(a); *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). A reference is in a different field of endeavor if it teaches use in a different structure, for a different purpose, under different conditions, than the claimed invention; and a reference is not reasonably pertinent to the problem with which the inventor was concerned if a person of ordinary skill in the art would not reasonably have expected to solve the problem of the claimed invention by considering references in the art of the reference. M.P.E.P. 2141.01(a); *In re Clay*, 23 USPQ 1058 (Fed. Cir. 1992).

Clark teaches a brush assembly for conducting electricity to and from railroad rails, for use in evaluating their structural integrity by magnetic induction. The Clark railroad rail testing device includes no support feature configured to support a user thereon; and is designed to be attached behind a high-rail vehicle, and pulled by the high-rail vehicle along a railroad rail. It is used on pre-existing railroad rails that are permanently fixed in place, and that certainly do not make themselves available for free placement by a user. The brush assembly is brought to wherever the railroad rails already happen to be in place, as opposed to the rails being manipulable by a user to facilitate navigation of a creeper to a desired location.

Each one of these characteristics therefore points to the inexorable conclusion that Clark teaches an eminently different structure, for an eminently different purpose, under eminently different conditions, than the subject matter of the present claims, and a person of ordinary skill in the art of the present claims would not reasonably have expected to solve the problem of the claimed invention by considering references in the art of Clark, as elaborated below.

The Clark reference was picked out of a non-analogous art relative either to Black or the present invention, rendering the combination an unfairly expansive evaluation of the scope and contents of the prior art. The attempt to link the field of art of Clark, i.e. of a brush assembly for conducting electricity to and from railroad rails for use in evaluating their structural integrity by magnetic induction, and the field of art of mechanic's creepers, constitutes an unorthodox leap of poetic license; it does not constitute a comparison between analogous fields of art under any meaningful definition of "analogous". If anything, it tries to bridge an even greater disparity than that involved in the Office's prior, now abandoned rejection based on the purportedly analogous relationship between a creeper and a conveyor system for a collapsible movie camera dolly.

Black and Clark share little if anything in common, in terms of structure, other than things having some sort of frame with wheels attached; and in terms of function, other than to facilitate motion of some thing; and in terms of conditions of use, other than some place within the realm of human activity. The disparate variety encompassed by these structures, functions, and conditions of use, define a vast, amorphous universe of subject matter, in the breadth of which it would be impossible for any mortal person to become skilled; and an invention can hardly have been obvious if no person can have been of ordinary skill in the entirety of the arts needed to provide references that disclose (assuming *arguendo* that they do) all the elements of that invention.

The very different structure, for a very different purpose, under very different conditions of use, between the teaching of Clark and the subject matter of the present claims presents compelling evidence that Clark is not from an analogous art to that of the present claims, and does not properly support an allegation of the present claims being obvious under §103. Furthermore, a person of ordinary skill in the art of the present invention would not reasonably have expected to solve the problems resolved by the subject matter of the present claims by considering references in the art of a brush assembly for conducting electricity to and from railroad rails for use in evaluating their structural integrity by magnetic induction, providing further powerful evidence that Clark is inapposite to the evaluation of the present claims under §103.

The conclusion that Black and Clark are from non-analogous arts, impermissible to combine for §103, is further supported by the lack of any overlap in the classifications, domestic or international, or fields of search, of the Black and Clark references. This is further indicative that a person of ordinary skill in the art of either one of the two references would not have considered investigating the field of art of the other reference as an analogous or reasonably pertinent source of knowledge for a particular problem.

The fact of Clark's non-analogy from the art of the present invention shows that the only rejection of the present claims is not sustainable. The applicant therefore respectfully requests that the Examiner withdraw this rejection and allow claims 2, 4, 5, 7, 8, and 12-18.

2. CLAIMS 2, 4, 5, 7, 8, AND 12-18 ARE NOT RENDERED OBVIOUS BECAUSE THERE WAS NO COMMON SENSE RATIONALE TO COMBINE BLACK AND CLARK

The differences between Black and Clark and the present claims are also too great for the claims to be obvious, because there would have been no motivation or common sense rationale to combine the disclosures of Black and Clark. Obviousness rejections must include an objective showing of specific facts to demonstrate a motivation to combine the references, at least through the ordinary skill and creativity and common sense that would have been used by a person of ordinary skill in the art. Obviousness rejections made without this sort of requisite showing have been consistently overturned, in a testament to the importance of this safeguard against undue exclusion of patentable inventions from the issuance of a patent. The differences between the cited references and the present claims, following the second of the *Graham* inquiries, therefore also provide an independent reason why the current obviousness rejection should be withdrawn and the present claims allowed.

In particular, there is no demonstrated suggestion or motivation to combine Black and Clark, either explicitly in the references themselves, or more tenuously in the general knowledge of those in the relevant arts or in the nature of the problem to be solved, or an objective showing of why the ordinary skill, creativity, and common sense of those in the art would have prompted a scheme to draw on magnetic induction testing devices for railroad rails

to inspire the development of new mechanic's creepers. None of these possible sources of motivation to combine the two references has been demonstrated by a factual inquiry of objective evidence, as would be required to establish a showing of obviousness. The post hoc pairing of the dramatically disparate Black and Clark references goes beyond any suggestion or motivation that anyone of ordinary skill in the arts of either reference would be alerted to, in staying competently informed within her own specialty. A motivation ascribed alternately to a nebulous common knowledge in the art would not fairly represent the reality of two separate fields of art, each with its own community possessing its own unique common knowledge: one community of persons with ordinary skill in the art of creepers, who might consider Black well-known in their art; and a separate community of persons with ordinary skill in the art of magnetic induction testing devices for structural flaws in railroad rails, who might consider Clark well-known in their art. A single individual who considered these two references from these two disparate specialties well-known, would not be a person of ordinary skill, creativity, or common sense in one art or the other, but rather a person of exceptional creativity and extraordinary skills across a polymathic range of arts, compared to whose talent little if anything might not be obvious. Such a standard would present an unfair and unstatutory yardstick for evaluating claimed inventions under §103.

Neither the cited references, nor the common knowledge of those in the art or the nature of the problem to be solved, include a suggestion to combine the disclosures of these two references as demonstrated by a specific factual inquiry of objective evidence. Even assuming *arguendo* that Black and Clark were to disclose or suggest every element of each of the present claims between the two of them, the present claims are not shown to be obvious without such a specific fact finding that a person skilled in the art at the time of the invention of the present claims would have had a motivation or objectively demonstrated common sense rationale to combine the teachings of these two references. Such a specific fact finding from objective evidence has not been shown. This is indicative that such a combination was in fact inventive, and deserving of being awarded a patent.

3. CLAIMS 2, 4, 5, 7, 8, AND 12-18 ARE NOT RENDERED OBVIOUS
BECAUSE BLACK AND CLARK TEACH AWAY FROM THEIR COMBINATION

The differences between Black and Clark and the present claims are too great for the claims to be obvious, because Black and Clark teach away from each other. This provides compelling evidence that a person of ordinary skill in the art at the time the present claims were invented would not have had motivation to combine the Black and Clark references. It is improper to combine references where references teach away from their combination. M.P.E.P. 2145(X)(D)(2); *In re Grasselli*, 218 USPQ 769, 779 (Fed. Cir. 1983).

As a particular example, Black emphasizes the importance of the tracks or sliding members being moveably connected together, and describes “the major advantage” of its subject matter to involve characteristics that are “due to the track means which are moveably connected to the platform or body support member...” (col. 2, lines 36-42; see also e.g. col. 1, lines 40-44, et al.; emphasis added). Black also emphasizes the forms of terrain on which the user chooses to temporarily lay the device, including the tracks. That being said, a person of ordinary skill in the art of Black would likely have been motivated *a fortiori* by the teaching of Black to dismiss out of hand a reference teaching a structure that, far from enabling a device that is freely positionable on terrain of the user’s choosing and having a platform connected to its tracks, instead deals with railroad tracks that have already long fixed in place, and with a moveable platform that temporarily contacts the tracks without being moveably connected thereto.

Many other examples could also be listed of aspects of the two references that contradict each other and teach away from any usefulness in connection with the other, though such a listing has no apparent necessity given the compelling surfeit of evidence already amassed herein to contradict the propriety of the rationale for the present rejection.

Otherwise, if there are not even more instances of Black and Clark teaching away from each other, it is simply because they are so non-analogous from each other that there are few points of direct comparison between them in the first place, few opportunities in which they even share elements in common from which to begin a comparison, such that they might realize the option to recommend against aspects taught by the other. For instance, Black devotes a

significant proportion of its disclosure to describing the capabilities of the creeper to support a user reclining thereon and enabling the user's control of the creeper. This might be considered as teaching away, since it emphasizes the importance of a user reclining on the creeper and engaging in useful aspects of the creeper while thus reclined, while Clark teaches a device that is not designed to support a user reclining thereon. Alternatively, this disparity might be considered not so much teaching away as much as merely an indication of how little these two references have with each other in the first place.

The combination of Black and Clark therefore does not properly support an allegation of non-obviousness of the present claims. On the contrary, the present claims describe a new and unobvious invention, deserving of allowance.

4. CLAIMS 2, 4, 5, 7, 8, AND 12-18 ARE NOT RENDERED OBVIOUS BECAUSE
KNOWLEDGE OF CLARK IS OUTSIDE THE ORDINARY SKILL, CREATIVITY, AND
COMMON SENSE IN THE ART

The rejection of claims 2, 4, 5, 7, 8, and 12-18 does not take into account the level of ordinary skill in the art of the present invention, because that level of ordinary skill, creativity and common sense of those in the art of creepers does not include the breadth of knowledge to make the cited combination. The ordinary level of skill in the art of the present invention is likely to center on familiarity with the mechanical structure and function of creepers and of the motor vehicles whose maintenance is facilitated by the creepers. This familiarity would be gained by experience and training that would be unlikely to include a detailed investigation of the specialized technologies of using magnetic induction to evaluate the potential presence of structural flaws in railroad rails, an art which in turn has no indicated regard or use for creepers. It is improper to evaluate ordinary skill of persons in the art by considering instead what would "have been obvious... to those skilled in remote arts." M.P.E.P. 2141.03; *Environmental Designs, Ltd. v. Union Oil Co.*, 218 USPQ 865, 869 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984). If one thing actually is obvious when regarding these two references, it is that a brush assembly for conducting electricity to and from railroad rails for use in evaluating their structural

integrity by magnetic induction, must be considered a remote art from the perspective of persons of ordinary skill in the art of creepers. Therefore, a proper adherence to the third of the *Graham* factual inquiries also, independently of the evaluation under the first two *Graham* inquiries, indicates that Clark does not support an allegation of obviousness for the present claims.

CONCLUSION: CLAIMS 2, 4, 5, 7, 8, AND 12-18 SHOULD BE ALLOWED

At least four legal rules spanning each of the first three *Graham* inquiries independently indicate that Black and Clark do not render the present claims obvious. The applicant respectfully requests that the Office reconsider and withdraw the present rejection as it withdrew the previous rejection in view of the applicant's appeal thereof, and that the Office instead allow claims 2, 4, 5, 7, 8, and 12-18, in addition to claims 6, 9-11, 19 and 20.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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